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Paper No. 4

David L Newman, Esq.
Method Electronics Inc
7444 West Wilson Avenue
Chicago, IL 60656

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JUL 21 2004

OFFICE OF PETITIONS

In re Application of :
Gilliland, Torres, :
Angelov, Schie and Ward : DECISION ON PETITION
Application No. 10/015,103 :
Filed: December 11, 2001 :
For: AUTOMATIC POWER CONTROL :
AND LASER EFFICIENCY :
NORMALIZONG CIRCUIT :

This is in response to a Request for Reconsideration of Petition under 37 CFR §§ 1.183 and 1.48, filed October 21, 2003 (Certificate of Mailing dated October 16, 2003, to waive the requirement of 37 CFR 1.48(a)(2) and (a)(3) and correct the inventorship in the above-identified application.

The petition is **dismissed**.

Applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.183 and 1.48", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Background

The above-identified application was filed on December 11, 2001, and included a "List of Inventor's Names" that listed five (5) inventors. Also filed were two (2) Declarations. The first Declaration listed three (3) inventors, the second Declaration listed one (1) inventor. The fifth inventor listed on the "List of Inventor's Names", was not included on any Declaration filed with this Office.

A Request for Corrected Filing Receipt and Petition under 37 CFR 1.47 were filed on June 27, 2002. The Request for Corrected Filing Receipt requested the addition of inventor Schie to the application and requested a corrected filing receipt reflecting this addition.

On August 28, 2002, a Response to the Request for Corrected Filing Receipt was mailed to Applicant, informing him that a petition under 37 CFR 1.48 was required to effect a change of the inventive entity.

Applicant subsequently filed a Petition to Treat Declaration and Assignment as Being Signed by All Inventors Pursuant to 37 CFR 1.47, on June 27, 2002. That petition was dismissed as inappropriate in a Decision mailed May 19, 2003. The Decision dismissing the petition required a petition under 37 CFR 1.48. Applicant was informed that a grantable petition under 37 CFR 1.48 would require waiver of 37 CFR 1.48(a)(2) (which requires a statement from each person being added that the error occurred without deceptive intent), and 37 CFR 1.48(a)(3) (which requires an oath or declaration executed by all inventors). The waiver under 37 CFR 1.48(a)(2) was required because the inventor sought to be added refused to join in the application or execute any documents associated therewith, and the waiver under 37 CFR 1.48(a)(3) was required because four (4) of the five (5) inventors were no longer employed with the Assignee, and their signatures would be difficult to obtain. Under 37 CFR 1.48(a)(3), an oath or Declaration which satisfies 37 CFR 1.47(a) is permitted to satisfy 37 CFR 1.48(a)(3).

Applicant was provided with the requirements of a grantable petition under 37 CFR 1.47(a), and informed that the oath or declaration as permitted under 37 CFR 1.47(a) must be executed by the available inventors.

The instant Request for Reconsideration

With the instant Request for Reconsideration, Applicant files Declarations listing all five (5) inventors; however, the Declarations are unexecuted.

Applicant also states in the instant Request for Reconsideration, that inventors Schie and Ward cannot be found or reached after a search "through local public listings

proximate to their last known address". *Request for Reconsideration* at p.2.

Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) and (2) as set forth above.

Analysis

As to item (1), if an inventor is unavailable (cannot be reached), while it is not required that the application be mailed, Petitioner must establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. A statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. (Emphasis supplied). See, MPEP § 409.03(d). At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the non-signing inventor may reside. Copies of the results of such searches must be referred to in any renewed petition. It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

Here, Applicant avers that a search "through local public listings proximate to their last known address" was performed; however, Applicant has failed to file any copies of search results or a statement of facts that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor(s).

As to item (2), Applicant has failed to provide an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116.

Here, because inventor Torres is available to execute the Declaration, his signature is required and will be considered as

inventor Torres making application on his own behalf, and on behalf of the nonsigning inventors.

A properly executed oath or declaration is required.

Alternative Approach

A review of the application history reveals that the above-identified application is a continuation of application 09/498,221, filed February 4, 2000, and that the inventive entity is the same as that as alleged in the instant application. **Applicant may, as an alternative,** file a copy of the oath or declaration from the parent application, and a copy of the rule 47 petition DECISION that was granted in the parent application. Accord 37 CFR 1.63.

The filing of the oath or declaration from the parent application, and a copy of the rule 47 petition decision that was granted in the parent application would satisfy 37 CFR 1.48(a)(3), and provide the basis for waiver of 37 CFR 1.48(a)(2).

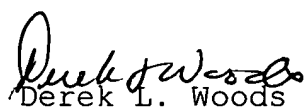
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202-3113

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.


Derek L. Woods
Petitions Attorney
Office of Petitions